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MAILED AUG 17 2006

In re Application of
HOWE, ALICE H.
Application No.: 10/635,873
Filed: August 05, 2003

: DECISION ON
: PETITION
: UNDER
: 37 CFR 1.181

This is a decision on the petition filed April 7, 2006 under 37 CFR 1.181 requesting the Director or other U.S. Patent Office Official to exercise supervisory authority with regard to the refusal of the examiner to enter exhibits in an appeal brief.

The petition is granted to the extent that prosecution is being reopened in this application.

Petitioner requests that Exhibits B-F of appellant's appeal brief filed on January 5, 2006 be entered. In support petitioner argues that the examiner is well aware of the contents of Exhibits B-F since these same Exhibits were part of the Appeal Brief of Appeal 2004-2020 of parent application 09/655,743. In addition, petitioner points out that the responses to the office actions of February 17, 2005 and August 11, 2005 incorporated by reference the papers filed in the parent application. That such incorporation by reference already made Exhibits B-F of record in the current application.

37 CFR 1.104(b) states:

Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

37 CFR 41.33 states:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 CFR 41.37(c)(2) states:

A brief shall not include any new or nonadmitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

MPEP 707.07(f) states in part:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

MPEP 201.06(c) states in part:

Affidavits or declarations, such as those submitted under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the prior nonprovisional application do not automatically become a part of a continuation or divisional application filed under 37 CFR 1.53(b). Where it is desired to rely on an earlier filed affidavit or declaration, the applicant should make such remarks of record in the 37 CFR 1.53(b) application and include a copy of the original affidavit or declaration filed in the prior nonprovisional application.

A review of the application does not provide a clear record of how Exhibits B-F were treated by the examiner prior to the filing of the appeal brief filed on January 5, 2006. The office action mailed on August 11, 2005 is silent as to the treatment of the incorporation by reference of the papers of the parent application. Since a copy of the affidavit or declaration (Exhibit D) was not provided in accordance with MPEP 201.06(c), the affidavit is not considered

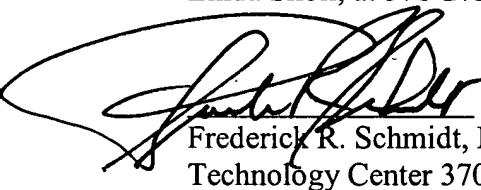
Art Unit: 3711

to be currently part of the record of the current application. In addition, there is no provision for incorporating by reference other types of exhibits. The file record of this application must be complete and petitioner must provide copies of any evidence to be considered by the examiner. Therefore, in accordance with 37 CFR 41.33 and 37 CFR 41.37(c)(2) exhibits B-F will not be admitted and the appeal brief filed on January 5, 2006 will not be entered.

However, as pointed out in 37 CFR 1.104(b) and MPEP 707.07(f), the examiner must supply a complete action to the applicant addressing all of applicant's arguments. Since petitioner's arguments were not addressed with regard to the incorporation by reference, the examiner is instructed to reopen prosecution to properly address applicant's incorporation by reference arguments.

The application is being forwarded to the examiner for an action not inconsistent with this decision.

Any questions regarding this decision should be directed to Special Program Examiner, Linda Sholl, at 571-272-4391.



Frederick R. Schmidt, Director
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